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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/091,001
Filing Date: March, 02, 2002
Appellant (s): Philip T. Mellinger, et al.

Irvin E. Branch
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/1/2005.

The Examiner presents to the Board of Appeals and Interferences the instant format of the Examiner's Answer based on the "old" Examiner's Answer practice rules since the Appellant's first timely Brief was filed under the "old" Appeal Brief practice rules.

(1) Real Party in Interest

A statement identifying the real party of interest is contained in the brief.

(2) Related Appeals and Interferences

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that:

claims 1, 3, and 7-12 do not stand or fall together;

claim 2 stands alone;

claim 4 stands alone;

claims 5 and 6 stand or fall together;

claims 13, 19-26, 28, 30, 31, and 37-47 stand or fall together;

claims 14 and 32 stand or fall together;

claims 15 and 33 stand or fall together;

claims 16 and 34 stand or fall together;

claims 17, 29 and 35 stand or fall together;

claims 18 and 36 stand or fall together;

Dependent claim 27 stands alone.

And provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,903,830

Joao et al. 05/11/1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-47, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao et al (US Patent No. 5,903,830).

As per claim 1, Joao et al. teach a computer system having methods of monitoring financial transactions comprising a means for receiving financial transaction information. The financial transaction information includes transaction records (i.e. spending habits, data of transaction, time of transaction, geographical area of spending and etc.) for a plurality of financial transactions that each has at least one associated account identifiers (column 8, lines 23-33) (column 16, lines 4-35). Joao et al. do not explicitly mention a means for periodically receiving a target account identifier of a suspect account, and a means for comparing the target account identifier with the transaction information to determine if the target account identifier matches any of the account identifiers of the transaction information. However, Joao et al. teaches a computer system having a processor processes accounts for any of the various banks and/or financial institutions which issue and/or manage credit cards, charge cards, debit cards, and/or currency or "smart card" and/or process or manage these accounts (column 4, lines 23-31).

The central processor of which is programmable and/or which

may provide for pre-programmed and/or pre-specified (col. 11, lines 53-58) (e.g. targeted accounts) so as to limit and/or restrict the amounts and/or types of the transactions (col. 7, lines 49-53). Further, Joao et al. teach a system includes a means for generating a real time notification (col. 8, line 61). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to realize that the system, as taught by Joao et al. is capable of having means for receiving the target account identifier is a suspect account and comparing the target account identifier with the transaction information to determine if the target account identifier matches any of the account identifiers of the transaction information so that to authorize or cancel the transactions. Furthermore, it would have been obvious to one skilled artisan to modify the current system to have the financial transaction information received at the computer system immediately after or while the transactions occur so as to compare the financial transactions of a plurality of the associated account identifiers of which are different from the target account identifiers.

As per claims 2 and 4, Joao et al. do not explicitly mention a notification transmitted electronically to a provider of the target account identifier.

However, Joao et al. teaches a computer system having a processor processes accounts for any of the various banks and/or financial institutions which issue and/or manage credit cards, charge cards, debit cards, and/or currency or "smart card" and/or process or manage these accounts (column 4, lines 23-31)', therefore, it would have been obvious to one skilled artisan in the art to automatically generate an alert

transmitted electronically to a provider and/or to a designee of a provider of the target account identifier when it appears to be unordinary.

As per claims 3 and 5, Joao et al. teach an alert transmitted electronically to the owner of the suspect account (column 6, lines 4-17) (column 8, lines 60-65).

Furthermore, it would have been obvious to generate a notification to any means relating to the account identifiers i.e. a compiler of marketing information and etc.

As per claim 6, it contains features addressed in claim 1, and therefore, is rejected under the same rationale.

As per claim 7, it contains features addressed in claim 1, and therefore, is rejected under the same rationale.

As per claim 8, it contains features addressed in claim 1, and therefore, is rejected under the same rationale.

As per claims 9-11, Joao et al. teach a computer system that is capable to compare and to transmit information (column 13, line 49- column 14, line 51).

As per claim 12 Joao et al. teach an alert (an electronic textual message) about the content of the electronic data (column 6, lines 4-17).

As per claim 13, it contains features addressed in the above claims, and therefore, is rejected under the same rationale. In addition, applicant recited a processing server. Joao et al. teach a server (450) coupled with the system to receive transaction information and it also generates an alert that the platform server has identified a transaction record having a target account identifier.

As per claim 14, Joao et al. do not explicitly mention the list comprising an electronic file from a government agency. However, Joao et al. disclose a computer system having a processor processes accounts for any of the various banks and/or financial institutions which issue and/or manage credit cards, charge cards, debit cards, and/or currency or "smart card" and/or process or manage these accounts (column 4, lines 23-31). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide services to a government agency as it provides services to various banks and/or financial institutions.

As per claims 15 and 16, Joao et al. do not mention explicitly the processing server processes the list daily (for example requested and received the list). However, Joao et al. teach a system that is capable to have a real-time notification. Therefore, it would have been obvious to one skilled artisan in the art to realize that the system, as taught by Joao et al. comprises a processing server processes daily.

As per claims 17 and 18, Joao et al. do not mention a means for transmitting from the processing server a list available message to at least one platform server indicating that the processing server has received a list, in response to which the at least one platform server transmits a request to the processing server to send the list. However, Joao et al. disclose a means for transferring a message from one location to another. In addition, Joao et al. also includes a means to await, receive and response to the message (see Figure 6). Therefore, it would have been obvious to one skilled artisan in the art to modify the system, as taught by Joao et al. to have a means for transmitting from the processing server a list available message to at least one platform

server indicating that the processing server has received a list, in response to which the at least one platform server transmits a request to the processing server to send the list.

As per claims 19-21, they contain features addressed in claims 3 and 5, and therefore, are rejected under the same rationale.

As per claims 22-24, Joao et al. do not explicitly mention the duration (about 15 or 1 minute) of the notification is being transmitted from the time that the alert is received. However, it would have been obvious to one skilled artisan in the art to understand that the duration of the notification can be transmitted depending on the set system. The system can be set to send a notification right after the alert was indicated or it can wait for a finite period of time.

As per claim 25, it contains features addressed in claim 1, and therefore, is rejected under the same rationale.

As per claim 26, Joao et al. do not explicitly mention the notification includes the account identifier, the data, the time and the address where the account identifier was used. However, Joao et al. teach a computer system that is capable to monitor the number of transactions of which are unauthorized by the cardholder (column 8, lines 24-27), and an alert means to the authorized card holder. Therefore, it would have been obvious to one skilled artisan in the art to modify the current system, as taught by Joao et al. to have a notification including the account identifier, the data, the time and the address where the account identifier was used.

As per claim 27, Joao et al. teach a system having a means for processing the alert at the processing server (450) by combining transaction data from the alert with

stored transaction data in the database (3H) relating to the target account identifier, and wherein the notification is based on the alert and the stored transaction data.

As per claim 28, it contains features addressed in claims 1 and 13, and therefore, is rejected under the same rationale.

As per claim 29, Joao et al. do not mention explicitly mention a means for requesting the list from the processing server. However, Joao et al. disclose a database (3H), and database comprises multiple lists so that the processor server can retrieve the information as needed. Therefore, it would have been obvious to one skilled artisan in the art to understand that the system, as taught by Joao et al. is capable of requesting the list from the processing server.

As per claim 30, it contains features addressed in claim 12, and therefore, is rejected under the same rationale.

As per claims 31-34, they contain features addressed in the above claims, and therefore, are rejected under the same rationale.

As per claims 35 and 36, Joao et al. do not mention a means for transmitting from the processing server a list available message to at least one platform server indicating that the processing server has received a list, in response to which the at least one platform server transmits a request to the processing server to send the list. However, Joao et al. disclose a means for transferring a message from one location to another. In addition, Joao et al. also includes a means to await, receive and response to the message (see Figure 6). Therefore, it would have been obvious to one skilled artisan in the art to modify the system, as taught by Joao et al. to have a means for

transmitting from the processing server a list available message to at least one platform server indicating that the processing server has received a list, in response to which the at least one platform server transmits a request to the processing server to send the list.

As per claims 37-39, 43-47, they contain features addressed in the above claims, and therefore, are rejected under the same rationale.

As per claims 40-42, the claims contain features addressed in claims 22-24, and therefore, are rejected under the same rationale.

(11) Response to Argument

The appellant argues that the Examiner uses Official Notice and requests a reference denoting various obviousness rationale applied in the prior Office action.

In response, the Examiner has not applied any Official Notice statement and thus, the requirement for a reference is not necessary. Furthermore, the appellant's request for a reference is properly challenged since a mere disagreement with the Examiner's position is insufficient for a request of a reference. Appellant is directed to *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420-421 (CCPA 1970). Bald statements such as "the examiner has not provided proof that this element is well known" or "applicant disagrees with the examiner's taking of Official Notice and hereby requests evidence in support thereof", are not adequate and do not shift the burden to the examiner to provide evidence in support of the Official Notice. Allowing such statements to challenge Official Notice would effectively destroy any incentive on the part of the Examiner to use it in the process of establishing a rejection of notoriously well known facts (*In re Boon*, 169 USPQ 231 (CCPA 1971)).

Furthermore, as per the appellant's arguments on hindsight reasoning, the Examiner notes that in *In re McLaughlin*, 170 USPQ 209 (CCPA 1971), any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at time claimed invention was made and **does not include knowledge gleaned only from applicant's disclosure.**

The Examiner further asserts that in a credit card system there exists a plurality of types credit cards wherein each card would have a status type such as lost or stolen, canceled, deactivated, over-the-limit, depleted-valued. Cards having normal status or cards not being in a delinquent status also exist. See column 5, lines 43-50 of Joao et al. It should also be noted that every day, normal users and/or also thieves use these cards to perform financial transactions. Joao et al teach that during a financial transaction, cards data and financial transactions data are transmitted to a remote computer. Thus, the claimed step of periodically receiving at a computer system, a target account identifier of a suspect account is taught by Joao et al. Note column 5, lines 26-39. The target identifier corresponds to at least one of the cards as being card with a status of lost or stolen, canceled, deactivated, over-the-limit, depleted-valued. Joao et al further teach the step of receiving financial transaction information at the computer system, the financial transaction information including transaction records for a plurality of financial transactions that each have at least one associated account identifier, wherein the financial transaction information is received at the computer system after or while the financial transactions occur, and wherein a plurality of the associated account identifiers are different from the target account identifiers. Appellant is directed to column 5, lines 26-50 of Joao et al. The plurality of account identifiers are different from the target account identifiers because in a financial systems there would exist a

plurality of account identifiers and wherein one or more card having an account identifier is used at a given time during a financial transaction.

Joao et al further teach that using the card information and transaction information, “the central processing computer will determine if the card has been lost, stolen, and/or cancelled and/or deactivated and/or if the credit, charge or debit account limit of the card has been reached and/or exceeded and/or if the currency value of the card has been depleted”. See column 5, lines 52-57 of Joao et al. Thus, from this passage, it would have been obvious to one of ordinary skill in the art to note that the card information and transaction information correspond to an account identifier. This card account identifier is to be compared with at least one or more account identifier so as to detect that the account identifier exists and the determination as to the status of the account identifier would be made. Thus, the step of comparing the target identifier with the transaction information as the financial transaction information is received at the computer system to determine if the target account identifier matches any of the account identifiers of the transaction information would have been obvious to one of ordinary skill in the art so as to determine the status of the target account identifier. In so doing, Joao et al discloses, upon the occurrence of a match, generating an alert having at least a portion of the transaction record that has an account identifier matching the target account identifier and transmitting the alert to a recipient. Note column 5, line 58 to column 6, line 61 of Joao et al.

As per claims 2 and 4 Joao et al do not explicitly teach the recipient comprises a provider of the target account identifier. However, Joao et al disclose transmitting an alert signal to any of a plurality of authorities. Note column 6, lines 2-3 of Joao et al. These may include financial

institutions as being the provider of the target account identifiers. Note column 4, lines 23-31 of Joao et al. It would have been obvious to one of ordinary skill in the art at the time the invention was made to transmit the alert signal to the a provider of the target account identifier in order to provide the provider with account activities such as fraud thereby, decreasing potential losses for both the client and the provider of the target account identifier.

As per claim 3, Joao et al disclose the recipient comprises an owner of the suspect account. Note columns 5 and 6 of Joao et al.

As per claims 5 and 6, the recipient being a compiler of marketing information relating to the account for monitoring the spending habits of a user of the suspect account is not explicitly stated. However, Joao et al disclose transmitting the transaction information to any of a plurality of recipients (note column 10, lines 48-63 of Joao et al.) and monitoring the spending habits of a user (note column 5, lines 58-67). Thus, the recipient comprising a compiler of marketing information from monitoring the spending habits of a user of the suspect credit card account would have been obvious to one of ordinary skill in the art to incorporate in Joao et al. in order to monitor fraud, spending habits of a cardholder and in order to determine what future products or services that the cardholder will need based on the results of a marketing analysis.

As per claims 13, 19-26, 28, 30, 31 and 37-47, appellant argues that limitations of an interaction between a processing server and one or more platform servers and receiving a list of

target account identifiers at a platform server and transmitting the list to one or more platform servers are neither taught or suggest by Joao et al.

In response, Joao et al. in a credit card system there would exist a plurality of types credit cards wherein each card would have a status type such as lost or stolen, canceled, deactivated, over-the-limit, depleted-valued. Cards having normal status or cards not being in a delinquent status also exist. See column 5, lines 43-50 of Joao et al. It should also be noted that every day, users and/or also thieves use these cards to perform financial transactions. Joao et al teach that during a financial transaction, cards data and financial transactions data are transmitted to a remote computer. Providing a server to receive this list of a plurality of target identifiers would have been obvious to one of ordinary skill in the art for storage purpose of these account identifiers in a well-organized computer system. Also, the step of transmitting at least a portion of the list to one or more platform servers, wherein the one or more platform servers are each configured to receive transaction information while the transactions are occurring in order to process associated financial transactions is not explicitly taught by Joao et al. However, having at least one or more platform servers would have been obvious to one of ordinary skill in the art because Joao et al teach processing financial transaction data for a plurality of types of cards (check card, charge cards, credit cards and smart cards), banks (savings and or checking) and other types of financial institutions. Having a plurality of servers would have been obvious to do in the system of Joao et al in order to transmit or store like data or same types of cards or data from the same banking or financial institution in the same server, therefore, providing a well organized computer system.

Furthermore, Joao et al teach receiving financial transaction information at the computer system, the financial transaction information including transaction records for a plurality of financial transactions that each have at least one associated account identifier, wherein the financial transaction information is received at the computer system after or while the financial transactions occur, and wherein a plurality of the associated account identifiers are different from the target account identifiers. Appellant is directed to column 5, lines 26-50 of Joao et al. The plurality of account identifiers are different from the target account identifiers because in a financial systems there would exist a plurality of account identifiers and wherein one or more card having an account identifier is used at a given time during a financial transaction

As per claims 14 and 32, appellant argues that Joao et al do not explicitly state that the list comprises an electronic file from a federal agency. However, Joao et al disclose receiving financial transmitting from a point of sales or from an ATM machine. A source being any entity such as the federal government does not affect the functioning of the system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a list of account identifiers be transmitted from a federal agency whenever the federal agency obtains suspected list of accounts. One of ordinary skill in the art would have been motivated to have the list comprising an electronic file from a federal agency in the system of Joao et al. so as to determine the likelihood of fraud and/or theft on a national basis and also to help fight credit and fraud..

As per claims 15 and 33, appellant argues the prior art fail to teach or suggest limitations relating to the list of target account identifiers being received by the processing server at least daily.

In response, Joao et al teach receiving transaction reports during a real time transaction. Joao et al does not explicitly teach receiving the list daily. The Examiner notes that if the list is to be received by another entity other than during a real-time financial transaction that it would have been preferable to make a compilation of the account identifiers and submit them daily as a list. The motivation would have been to transmit the list during a one time period so as to decrease transmission cost and time.

As per claims 16 and 34, appellant argues that the prior art fails to teach or suggest limitations relating to the list of target account identifiers being requested by a platform server, in some cases, in response to a notification from the processing server that the list is available.

In response, Joao et al teach that a plurality of types of cards is processed. A plurality of servers would have been needed to store and/or process these data and by sending similar type of data representing similar types of accounts to a distinct server. The motivation would have been to categorize the information thus facilitating processing, searching and retrieval of these information. Thus, a server requesting the list of information would have been obvious to one of ordinary skill in the art as processing of a type of information would have been needed or would have been made available for processing purposes so as to determine the possibility of fraud involving related account identifiers.

As per claims 17, 29 and 35, appellant argues that the prior art taken alone or in combination fails to teach or suggest limitations relating to the target account identifier list being requested by a platform server, in response to a notification from the processing server.

In response, appellant is referred to the argument related to claims 16 and 34 above.

As per claims 18 and 36, appellant argues that the prior art fail to teach or suggest limitations relating to the target account identifier list being sent from the processing server to at least one platform server upon receipt of the list by the processing server.

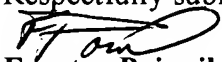
In response, the Examiner notes that the processing server is a main server that is used to distribute the different types of information or data to the related server. Thus, the target account identifier list being sent from the processing server to at least one platform server upon receipt of the list by the processing server would have been obvious to one of ordinary skill in the art at the time of the invention in order to distribute the information to their appropriate location or sever.

As per claim 27, appellant argues that the prior art fails to teach or suggest limitation that the alert includes stored transaction data relating to the target account identifier.

In response, Joao et al disclose transmitting the transaction data to the recipient or owner of the card. Note columns 5 and 6. Transmitting stored transaction data relating to the target account identifier would have been obvious to one of ordinary skill in the art at the time of the invention in the system of Joao et al. in order to provide the recipient with a complete list of information relating to their account thus facilitating reviewing of their transaction.

For the above reasons, it is believed that the rejections should be sustained.

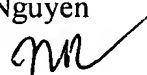
Respectfully submitted,


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April 11, 2006

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